REMARKS

By this Amendment, claims 1-5, 7, 9-11, 15-18, 45-46, 51, 60-61 and 66 are canceled and claims 19, 28, 35, 37, 52-53 and 67 are amended. Accordingly, claims 19-22, 24, 26-28, 32-41, 43, 47, 52-56, 58, 62 and 67 are pending in this application.

The Office Action rejects claims 1-5, 7, 9-11, 15-17, 19-22, 24, 26-28, 32-34, 37-41, 43, 45-47, 51, 53-56, 58, 60-62 and 66 under 35 U.S.C. §112, second paragraph, as being incomplete for omitting essential structural cooperative relationships of elements. This rejection is moot with respect to canceled claims 1-5, 7, 9-11, 15-17, 45, 46, 51, 60, 61 and 66, and is respectfully traversed with respect to the remaining claims.

The Office Actions asserts that the above noted claims recite, or are dependent upon a claim that recites n^2 areas and that the value of n is essential to the cooperative relationship of elements. Applicants respectfully disagree.

Independent claims 19, 37 and 53 recite *inter alia*, a display screen divided into n^2 areas, in each area of which is displayed a reduced image that is smaller than $1/n$ height by $1/n$ width of the display screen. Applicants respectfully submit that the number of areas in which to divide the display is subjective and is dependent upon the size of the display. Thus, n is a <u>variable</u> and is properly recited as such. It would be known to one of ordinary skill in the art to select a value of n appropriate to the size of the screen so as to have a reduced image viewing area discernable to the viewer. Accordingly, there is no need to specify a value of n.

The Office Action further asserts that dividing a display into n^2 areas is non-feasibility as n approaches an arbitrarily high number. Applicants respectfully submit that non-feasibility of specific values of n does not render the claim incomplete under 35 U.S.C. §112, second paragraph. As previously stated, it would be known to one of ordinary skill in the art to select a value of n appropriate to the size of the screen so as to have n^2 viewing areas discernable to the viewer. Thus, the value of n, being subject to the size of the display screen

and the discretion of the user, is a <u>variable</u> and therefore a specific value of n is not essential to the invention described in the specification.

The Office Action further asserts that although n^2 may pertain to a number of areas, 1/n does not describe any unit of distance, and is thus a critical omitted relationship under 35 U.S.C. §112, second paragraph. Applicants again respectfully disagree. 1/n as recited in the claims relates the dimensions, height and width, of each area that the display screen is divided into according to n^2. Thus, 1/n does not "describe any unit of distance" because 1/n is a fraction that relates the size of the areas to the number of areas. Both the number of areas and the size of the areas will depend upon the size of the display screen, and one of ordinary skill in the art would select an appropriate value of n based on the size of the display screen, thus determining the fraction of the display screen which the height and width of each area are smaller than.

In view of the foregoing, Applicants respectfully submit that claims 19-22, 24, 26-28, 32-34, 37-41, 43, 47, 53-56, 58 and 62 fully comply with 35 U.S.C. §112, second paragraph. Accordingly, withdrawal of the rejection is respectfully requested.

The Office Action rejects claims 1-5, 7, 9-11, 15-22, 24, 26-28, 32-41, 43, 45-47, 51-56, 58, 60-62 and 66-67 under 35 U.S.C. §103(a) over U.S. Patent No. 5,404,316 to Klinger et al. (hereafter "Klinger") in view of U.S. Patent No. 5,999,173 to Ubillos. This rejection is moot with respect to canceled claims 1-5, 7, 9-11, 15-18, 45, 46, 51, 60, 61 and 66 and is respectfully traversed with respect to the remaining claims.

The Office Action acknowledges that the disclosure of Klinger is incomplete and relies on Ubillos to allegedly resolve the deficiencies. Specifically, the Office Action acknowledges that Klinger fails to disclose the existence of a symbol inside the area to represent the other data as recited in claims 1, 19 and 53. Applicants respectfully submit that Ubillos fails to make up for the deficiencies of Klinger.

Independent claims 19, 35, 37, 52-53 and 67 recites, *inter alia*, a controller, coupled to a memory that divides a display screen into n^2 areas and displays each of the images and other information data in one of the n^2 areas of the display screen.

The Office Action, in referring to Figs. 3 and 5 and col. 7 lines 14-50, asserts that Klinger shows the information processing apparatus having dividing means for dividing a display screen into n^2 areas. Applicants respectfully disagree.

What Klinger does disclose, in Figs. 3 and 5 and col. 7, lines 14-50, are portions of a grid, and more specifically, <u>cutoff images</u> on the right most column and bottom most row of the screen that can only be viewed by the inclusion of a "horizontal slider 112 and vertical slider 114." Therefore, by having columns and rows displaying cutoff images, the grid disclosed by Klinger may extend beyond the display screen, an occurrence that can only be the result of the failure to divide the screen into n^2 areas. Nowhere does Klinger or Ubillos disclose, teach or suggest dividing the display screen into n^2 areas, as recited in independent claims 19, 35, 37, 52-53 and 67.

Similarly, Klinger and Ubillos both fail to disclose, teach or suggest storing the plurality of images and other information relative to each other "according to a predetermined storing order" and displaying the images and other information in the n^2 areas of the screen "according to the predetermined storing order," as recited in claims 19, 37, 52-53 and 67.

Accordingly, Applicants respectfully submit that independent claims 19, 35, 37, 52-53 and 67 are patentable due to the failure of Klinger and Ubillos to disclose, teach or suggest all recited elements of the claims. Claims 20-22, 24, 26-28, 32-34, 36, 38-41, 43, 47, 52, 54-56, 58 and 62 variously depend from independent claims and are likewise patentable over the applied art for at least their dependence on an allowable base claim, as well as for additional features they recite. Accordingly, withdrawal of this rejection is respectfully requested.

Furthermore, notwithstanding the lack of explicit or implicit disclosure of all claimed elements in the combined disclosure of Klinger and Ubillos, Applicants respectfully submit that the combination or modification of references cannot render the resultant combination obvious unless the prior art also suggest the desirability of the combination. In the rejection under 35 U.S.C. §103(a) over Klinger and Ubillos, the Office Action asserts that Ubillos makes up for the deficiencies of Klinger by disclosing a symbol placed in reduced image areas to represent other data. The Office Action further asserts that it would have been obvious to combine the symbol representation as disclosed by Ubillos with the grid disclosed by Klinger because it would provide a convenient way to represent and view other data. Applicants respectfully submit that the combination of Klinger and Ubillos is improper, and appears to be based on hindsight reasoning.

Klinger discloses a desktop video processing system having a display screen for displaying a grid of video clips. Nowhere does Klinger disclose the displaying of other information data, as recited in the rejected claims. Ubillos, on the other hand, discloses a method and apparatus for video editing which includes video clip representations as well as audio clips and still clips. However, Applicants submit that, as shown in Figs. 3, 4 and 5, not only does Ubillos fail to disclose a display screen divided into n^2 areas and displaying images in a predetermined order, but by the very nature of video editing, whereby a user can cut and paste together random video clips, Ubillos teaches away from a predetermined display order. For example, Ubillos at col. 5, lines 33-36, describe a method whereby the user selects stored video clips and other data clips from a mass storage device and displays the selections in a project window.
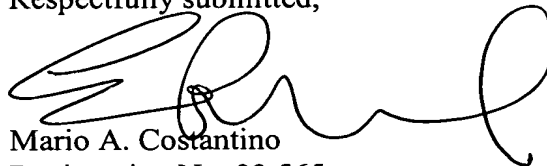
Applicants respectfully submit that neither Klinger nor Ubillos suggest the desirability of combining such teachings. It is improper to use the claimed invention as an instruction manual to piece together the teachings of the prior art so that the claimed invention is

Application No. 08/965,197

rendered obvious. The Office Action appears to use improper hindsight reconstruction to pick and choose among isolated disclosures. Accordingly, it is respectfully submitted that the combination is improper, and should therefore be withdrawn.

In view of the foregoing, it is respectfully submitted that this application is in condition for allowance. Favorable reconsideration and prompt allowance of claims 19-22, 24, 26-28, 32-41, 43, 47, 52-56, 58, 62 and 67 are earnestly solicited.

Should the Examiner believe that anything further would be desirable in order to place this application in even better condition for allowance, the Examiner is invited to contact the undersigned at the telephone number set forth below.

Respectfully submitted,

Mario A. Costantino
Registration No. 33,565

Eliot R. Malamud
Registration No. 51,989

MAC:ERM/aaw
Attachment:
    Petition for Extension of Time

Date: <u>December 22, 2004</u>

OLIFF & BERRIDGE, PLC
P.O. Box 19928
Alexandria, Virginia 22320
Telephone: (703) 836-6400

DEPOSIT ACCOUNT USE
AUTHORIZATION
Please grant any extension
necessary for entry;
Charge any fee due to our
Deposit Account No. 15-0461